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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,301	03/10/2004	Jun Hamakita	K06-167785M/TBS	9114
21254 7590 09/10/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER SCHARICH, MARC A	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,301	Applicant(s) HAMAKITA ET AL.	
	Examiner Marc A. Scharich	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/19/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED FINAL ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 10, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eda et al., U.S. Patent No. 5,482,127, in view of Lewis, U.S. Patent No. 3,234,758. Eda et al. discloses an electric power steering device (100) (*shown overall in FIG. 1 and more detailed in FIG. 2*) for transmitting a rotation of an electric motor (102) for assisting operation of steering which is reduced via a speed reduction mechanism [*comprised of reduction worm gear (103a) and worm wheel (104)*] to a steering mechanism (not shown). The electric power steering device (100) further contains a joint comprising a first transmission shaft (130) that contains a male spline portion (130b); a cylindrical portion (131b) that contains a female spline portion (131c) that mutually engages with the male spline portion (130b) and appears to be completely devoid of an O-ring; and the joint ultimately being connected to a rotary shaft (not shown) of electric motor (102) for transmitting the rotation of the motor (102) to the speed reduction mechanism [*reduction worm gear (103a) and worm wheel (104)*].

Eda et al. *fails to disclose or suggest* a motivation for: charging grease in a gap between the male splined portion of the first transmission shaft and the female splined

portion on the cylindrical body; the grease including a base oil having a kinetic viscosity of 1000 to 5000 mm²/s (40°C), and a worked penetration of the grease being not more than 300; or the kinetic viscosity of the base oil being not more than 2500 mm²/s; or the kinetic viscosity of the base oil being not less than 1500 mm²/s; or the worked penetration of the grease being not more than 260; or the worked penetration of the grease being not less than 200.

It has been well-known in the art for many years, *however*, that various compositions of lubricants may be included ("charged") between male and female spline engagements that rotate and endure load (torque). For instance, Lewis discloses a drive shaft slip spline assembly which includes a rotating driving means (12) with axial male splines (17) that engage axial female splines on an inner circumferential periphery (16) of a cylindrical end piece (14) that is connected to a vehicle drive shaft (10). Further, Lewis discloses that lubricants, such as grease or oil, may be employed between male and female spline portions (i.e. col. 2, lines 27-29). It is also known, and as Lewis discloses, that higher viscosity lubricants, such as heavy oils and greases, have customarily been employed to lubricate highly loaded contacting surfaces (col. 1, lines 28-30) (such as between the male and female splines of the disclosed invention of Lewis) for obvious reasons such as helping to relieve friction in high loaded [torque] conditions to prevent wear and friction in jointed assemblies with slip splines. Although Lewis does not specifically disclose or mention specific greases having kinematic viscosities or worked penetrations within the claimed values of the present application, it is well-known and obvious that greases with various physical properties are on the

market and may be *optimally selected and used* (i.e. based on testing or other experimentation) in such a manner as to be optimal for the intended application. Basically, kinematic viscosities or worked penetrations are merely tested physical properties (i.e. per ASTM –D445 standards) of lubricants, NOT part of an actual chemical composition, and it is well-known and obvious to select and try optimal greases with appropriate physical properties to optimize a function on a particular mechanical application (such as providing a desired effect between male and female splines). Therefore, considering the teachings of Lewis (utilization of grease between male and female spline joints) and the well-known fact that greases available on the market with certain known physical properties may optimize a particular mechanical application, it would have been *blatantly obvious* to one having ordinary skill in the art at the time of the invention to include or “charge” grease in a gap between the male splined portion of the first transmission shaft and the female splined portion on the cylindrical body on Eda et al.’s invention (*for the benefits as discussed above*) with an available grease on the market that exhibits such known physical properties of kinematic viscosity and worked penetration in the ranges as claimed by the present application in order to reduce wear or friction in the rotating spline joint.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eda et al., U.S. Patent No. 5,482,127, in view of Lewis, U.S. Patent No. 3,234,758, and in further view of Kobayashi et al., U.S. Patent No. 6,900,564. In combination, Eda et al. and Lewis fail to disclose a worm wheel comprising a synthetic resin, such as polyacetal, terephthalate, or polybutylene terephthalate. Kobayashi et al discloses an

electric power steering system, very similar in nature to that of Eda et al., with a worm wheel (19), having teeth formed of a polyacetal resin (POM). It is very well known and *blatently obvious* that such gears or worm wheels may be manufactured from many materials (such as metals or polymers) depending on the particular application.

Therefore, based on the teachings of Kobayashi et al., it would have been obvious to one having ordinary skill in the art at the time of the invention to manufacture the worm wheel (or part of the worm wheel) in Eda et al.'s invention, and in combination with the teachings of Lewis, out of a polyacetal resin (POM) for optimal performance depending on the operating conditions of the particular application in which the worm wheel is utilized.

Response to Arguments

2. Applicant's Remarks (received 6/19/2007) with respect to claims 1-5, 10-12 and 14 have been fully considered. The examiner, *however*, respectfully disagrees with the Applicant's arguments.

From the Remarks received on 6/19/2007, the Applicants argue:

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Argument: The Examiner, however, alleges that these features of the claimed invention are "well- known". However, the Examiner does not provide any support (e.g., a prior art reference properly combinable with Eda and Lewis) for this allegation.

Indeed, it appears that the Examiner has invoked official notice for claim 1, because the Examiner has not provided any teaching in Eda nor Lewis (nor anywhere else for that

matter) to support his allegation. Applicants submit that the Examiner has inappropriately invoked official notice in the rejection of claim 1.

Examiner's Response: The Examiner did not invoke official notice, nor did the Examiner even mention or intend to imply official notice. The Examiner is merely stating that various greases that exhibit various physical properties (*such as kinematic viscosities or worked penetration properties*) are well-known and are readily available on the market. It is a fact that lubricant manufacturers produce greases that are available with a variety of kinematic viscosities and worked penetrations and are available for selection, purchase and use for a desired application.

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Argument: The alleged combination of Eda and Lewis fails to teach or suggest an electric power steering device including "*a grease including a base oil having a kinetic viscosity of 1000 to 5000 mm²/s (40 °C), a worked penetration of said grease being not more than 300, and which is charged in a gap between said spline shaft and said cylindrical body, wherein the electric power steering device is devoid of an O-ring between said spline shaft and said cylindrical body*", as recited in claim 1, and similarly recited in claims 12 and 14 (*because*) Eda and Lewis do not even mention a kinetic viscosity of a grease, let alone teach or suggest the specific limitations of the claimed invention.

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Examiner's Response: In regard to claims 1-5, 10, 12 and 14, the combination of Eda and Lewis teach or suggest essentially all that is claimed [*i.e.* the electric steering apparatus, male/female spline engagement with no disclosed O-ring, and use of grease within the spline engagement], *except the specific properties* of the grease used to lubricate the spline engagement. The applicants claiming *the use* of grease that has certain physical properties within a certain optimal range is *obvious* and the combined prior art need not disclose a *specific* teaching, suggestion, or motivation to support a finding of obviousness {See recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>)}.

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Argument: Indeed, as pointed out in the Specification (e.g., see pages 1-3), conventional techniques use greases having either low viscosities (e.g., 100 to 300 mm²/s) or high viscosities (e.g., 10,000 to 30,000 mm²/s). When a grease having a low viscosity is used gear noise is generated in the engagement portion. When a grease having a high viscosity is used, it is difficult to insert and engage the male engagement member with the female engagement member.

According to the claimed invention, a grease having an intermediate viscosity (e.g., 1000 to 5000 mm²/s) is used. Use of the claimed intermediate viscosity alleviates the above problems (e.g., see Application at page 13, line 15 through page 14, line 2).

Therefore, the features recited in claim 1 are clearly important and are more than a mere design choice. Therefore, it is clearly erroneous for the Examiner to dismiss these features as "well known" without providing any support for his allegations.

Examiner's Response: The Applicant's arguments above indirectly support the Examiner's position that selecting an appropriate grease with desired physical properties would have been *obvious* to one having ordinary skill in the art. The applicants openly admit the difficulties of using conventional greases with low or high viscosities. Considering the Applicant's admission, wouldn't it then be *obvious* to one of ordinary skill to perhaps use or try a grease having a kinematic viscosity within an intermediate range of values? It is not disclosed anywhere in the present application that the applicants have actually invented the grease, or any chemical compositions of the grease for that matter, yet the applicants claim using a specific grease [(i.e. a *grease including a base oil having a kinetic viscosity of 1000 to 5000 mm²/s (40 °C)*]. The Examiner believes that such a grease having such specific values were not just randomly selected, but were optimally chosen based on testing and/or other experimentation. In conclusion, the applicants have merely chosen and claimed using an optimal grease available on the market (*since they haven't disclosed inventing the grease*) having an intermediate range of physical properties to optimize a particular indented application, which would have been obvious to one having ordinary skill in the art to do.

Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A. Scharich whose telephone number is (571) 272-3244. The examiner can normally be reached on M-F 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.S. – 8/31/2007



Marc A. Scharich
Patent Examiner
Art Unit 3611



LESLEY D. MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600